

Response To Restriction Requirement
U.S. Application Serial No. 10/723,183
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I. ELECTION WITH TRAVERSE

Applicants choose to restrict the application to the Group I claims with traverse. In other words, Applicants elect to prosecute claims 4-24, with claims 4, 12, and 18 being the independent claims in the group. Claims 25-33 are thus hereby withdrawn provisionally, with the understanding that they will be reinstated should it be determined that the relevant regulations require rescission of the restriction requirement.

II. ARGUMENTS IN SUPPORT OF WITHDRAWAL OF REQUIREMENT

Applicants respectfully request that the restriction requirement imposed in the 15 November 2006 *Office Action* be reconsidered under 37 C.F.R. § 1.144, and that the elected and non-elected claim groupings (4-24 and 25-33, respectively) be rejoined in this application.

The withdrawal of the restriction requirement is warranted under the regulations because the examiner will suffer no "serious burden" if the restriction is not required. In support of Applicants' request for withdrawal, the undersigned sets forth the following:

1. The prosecution of the above-identified application between Applicants and two successive examiners has proceeded as follows:

(a) On 21 October 2005, Examiner Sonal Prasad (hereafter "the first examiner") issued a *Restriction Requirement* in which restriction was mandated between two claim groups. Claim Group I, consisting of claims 1-3, is directed to an injector system. Claim Group II, consisting of claims 4-33, is directed to a battery charger system/module for use with an injector/battery powered system.

(b) On 11 November 2005, Applicants filed a *Response To Restriction Requirement* in which they elected the Group II claims (4-33) for further prosecution.

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(c) On 25 January 2006, the first examiner issued a first *Office Action* on the merits in which all pending claims (4-33) were examined. In particular, the *Office Action*:

(1) rejected claims 4-8, 12-14, 18-21, 25-27, 30 and 32 as being anticipated under 35 U.S.C. §102(b) by U.S. Patent Application Publication 2002/0169415

A1 to *Staats et al*; and

(2) indicated that claims 9-11, 15-17, 22-24, 28, 29, 31 and 33 would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims.

(d) On 25 July 2006, in a *Response* to the 25 January 2006 *Office Action*, Applicants presented arguments that they believe patentably distinguish the rejected claims (4-8, 12-14, 18-21, 25-27, 30 and 32) from the teachings in the *Staats et al.* reference, and thus sought allowance of all pending claims (4-33) as originally presented.

(e) Now, in a mailing dated 15 November 2006, a new examiner, namely Examiner Andrew M. Gilbert (hereafter "the second examiner"), issued this second *Restriction Requirement*, this one mandating further restriction of the Group II claims (4-33) above into one of two secondary groupings. In pertinent part, this *Restriction Requirement* stated:

(1) Claims 4-11, 12-17, 18-24, drawn to a battery charger system having a power supply, a battery pack including a battery and a charging module that monitors the operating mode of the injector system and if the system is in idle mode -the module provides DC power to the battery for charging, and if the system is in non-idle mode the module prevents the DC power from reaching the battery and enables the battery to provide DC power to the system, classified in class 320, subclass 127.

(2) Claims 25-31, 32-33, drawn to a charging module having an output selector stage providing a turn-on signal when the system is operating in an idle mode and a turn-off signal when the system is operating [sic] a non-idle mode, a charging stage that if it receives the turn-off signal it prevents the battery from being charged by the power supply and allows the powering of the system and if it receives

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the turn-on signal it allows DC power from the power supply to be conveyed to the system assuming: (a) a low current charging mode, (b) a multi-state charging mode - wherein the charging operates according to (i) a bulk-charge state, (ii) an overcharge state, (iii) a standby state, classified in class 340, subclass 636.11.

2. A requirement for restriction is not proper unless two criteria are met: (A) the inventions must be independent or distinct as claimed; and (B) there would be a serious burden on the examiner if restriction is not required. §803 of the Manual of Patent Examining Procedure (M.P.E.P.) (Rev. 5, Aug. 2006). The term “independent (i.e., unrelated)” means that “there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation and effect.” Id. at p. 800-3. Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure), operation (e.g., function), or effect. Id. Examples of related inventions include combination and part (subcombination) thereof. Id.

3. To support a requirement for restriction between combination and subcombination inventions, an examiner must establish both two-way distinctness and reasons for insisting on restriction (i.e., serious burden on examiner if restriction not required). M.P.E.P. §806.05(c).

(a) As for the first criteria, the inventions have two-way distinctness if it can be shown that (i) the combination as claimed does not require the particulars of the subcombination as claimed for patentability; and (ii) the subcombination can be shown to have utility either by itself or in another materially different combination. When these factors cannot be shown, such inventions are not distinct. Id. at p. 800-44.

(b) As for the second criteria (i.e., establishing reasons for insisting upon restriction), M.P.E.P. §808.02 mandates that “the examiner must show by appropriate explanation one of the following” (emphasis added):

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(A) Separate Classification: Each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search;

(B) Separate Status In The Art When Classifiable Together: Even if they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) Different Field of Search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), a different field of search is shown, even though the two are classified together.

4. Applicants respectfully submit that the reasons for insisting upon restriction required by M.P.E.P. §806.05(c) have not been established. The prosecution history of the application (inclusive of the claims at issue) reveals that no serious burden would be imposed on the Examiner if the Group II claims (4-33) above were not further restricted into secondary groupings 4-24 (*battery charger system for a battery-powered system*) and 25-33 (*charging module for a battery of a battery-powered system*). Specifically, the prosecution history of the application shows that:

(a) First, in the first *Restriction Requirement* (21 October 2005) as a result of which the application was restricted to the Group II claims (4-33) above, the first examiner did not require, or even mention the possibility of, the further restriction of the application into the two secondary groupings (e.g., 4-24 and 25-33) at issue here.

(b) Second, in the 25 January 2006 *Office Action*, the first examiner found no burden whatsoever, much less a serious one, in not requiring the further restriction. In fact, the first examiner examined all of the Group II claims (4-33) on the merits,

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concluding only that claims 4-8, 12-14, 18-21, 25-27, 30 & 32 were anticipated by the *Staats et al.* reference and that claims 9-11, 15-17, 22-24, 28, 29, 31 & 33 would be allowable if rewritten to include the limitations of the base and any intervening claims. The 25 January 2006 *Office Action* thus makes clear that there was no substantial burden in the complete examination on the merits of claims 4-33, as the same prior art was cited in connection with each of independent claims 4, 12, 18, 25 and 32. Moreover, each of the features in these claims was addressed with specificity in the *Office Action*.

(c) Third, in the second *Restriction Requirement* (15 November 2006), there is no "appropriate explanation" given for the reasons for restriction, as required by M.P.E.P. §808.02. The *Restriction Requirement* at issue merely states that "there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a ***separate status in the art*** due to their recognized divergent subject matter...." (emphasis added)

Contrary to the mandate of M.P.E.P. §808.02(B) for restriction requirements imposed on the basis of "***separate status in the art***" (see paragraph 3(b) above), the provision on which the second examiner relied here, the second "examiner [did not] show a recognition of separate inventive effort by inventors" nor did the examiner "cit[e] [any] patents [as] evidence of such separate status [and/or] of a separate field of search."

(d) Fourth, M.P.E.P. §811.02 addresses the situation where a previous restriction requirement has been complied with and then a second requirement is made. Although it allows for restriction "after a first action on the merits," it permits a second restriction only "when it becomes proper." The examiner, of course, must still show that he/she will face a serious burden if restriction is not required. In this regard, M.P.E.P.

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§811 expressly states that "the examiner should make a proper requirement as early as possible..., in the first action if possible, otherwise as the need for a proper requirement develops."

As the prosecution history clearly shows, the need for a further restriction has not developed during the prosecution of the application at issue. In particular, in their 25 July 2006 *Response* to the 25 January 2006 *Office Action*, Applicants actually relieved the examiner of certain examining burdens rather than developing further burdens. Their 25 July 2006 *Response* did nothing more than provide arguments in support of patentability of claims 4-33, as none of the claims were amended therein. In fact, the claims (4-33) currently pending are the same as those submitted with the application as filed, so all the claim elements that were examined by the first examiner in the first *Office Action* remain the same as those left for the second examiner to consider. Therefore, Applicants' *Response* cannot be the source of any developed burden on the second examiner, let alone a serious one, in the complete examination of claims 4-24 and 25-33 on the merits.

In summary, it is clear that no serious burden has arisen if further restriction is not required, neither from the claims as initially presented as is amply clear from the 25 January 2006 *Office Action* nor from any developed burden as is evident from the prosecution history since.

5. In view of the foregoing, since it has been established that no serious burden initially existed with respect to the initial examination of claims 4-33 in the 25 January 2006 *Office Action*, and Applicants' 25 July 2006 *Response* actually relieved the examining burden rather than developing an undue burden on the examination process, the finality of the second *Restriction Requirement* (15 November 2006) should be withdrawn and the elected claims 4-24 and the non-elected claims 25-33 be rejoined in this application.

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The Commissioner of Patents and Trademarks is hereby authorized to charge any fees which may be required for consideration of this *Response To Restriction Requirement* to Deposit Account No. 13-2530.

Respectfully submitted,


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